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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/086,661	02/28/2002	Elliot Brenhouse	7190-201	2308
<div>27383      7590      11/14/2007</div> <div>CLIFFORD CHANCE US LLP</div> <div>31 WEST 52ND STREET</div> <div>NEW YORK, NY 10019-6131</div>				
			EXAMINER	
			O'CONNOR, GERALD J	
			ART UNIT	PAPER NUMBER
			3627	
			MAIL DATE	DELIVERY MODE
			11/14/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/086,661

Applicant(s)

Brenhouse

Examiner

O'Connor

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on June 29, 2007 (RCE w/Amdt).
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5-16 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on May 22, 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 29, 2007 has been entered.

### ***Preliminary Remarks***

2. This Office action responds to the amendment and arguments filed by applicant on June 29, 2007 in reply to the previous Office action on the merits, mailed February 1, 2007.
3. The amendment of claims 1-3, 5-7, 9, 11, and 14-16 by applicant in the reply filed June 29, 2007 is hereby acknowledged.
4. The cancellation of claims 4 and 17-28 by applicant in the reply filed June 29, 2007 is hereby acknowledged.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

6. Claims 1-3, 7, and 11-15 are rejected under 35 U.S.C. 102(e) as being anticipated by Mason (US 6,497,361).

Mason discloses a customer self-checkout system for processing article purchases of articles, the system comprising: a self-checkout station 12 comprising: an input device 38 configured to receive product code input designating an article for purchase; a deactivation device 42 configured to produce a deactivation region effecting deactivation of a security tag 86 attached to the article for purchase; and a prompting system 24, 34 configured to present a deactivation prompt to direct a user to position the article for purchase within the deactivation

region to effect the security tag deactivation, wherein the prompting system is configured to present the deactivation prompt after the receipt of the product code by the input device.

Regarding claim 2, in the system of Mason the prompting system is configured to present an initial prompt directing a user to enter a product code using the input device.

Regarding claim 3, the system of Mason further comprises: a target 36 visibly disposed proximate the deactivation region at the checkout station; and wherein the deactivation prompt instructs the user to move the article to touch the target to effect security tag deactivation.

Regarding claim 7, the system of Mason further comprises a sensor 40 for sensing the presence of the article within the deactivation region.

Regarding claim 11, in the system of Mason the prompting system is configured to present a feedback prompt to confirm deactivation of the security tag after the sensor senses presence of the article within the deactivation region.

Regarding claim 12, in the system of Mason the feedback prompt comprises a prompt instructing the user to place the article in a bag.

Regarding claim 13, in the system of Mason the input device comprises a device selected from the group consisting of a bar code scanner, a scanner-scale module, a touch-screen display, and a keypad.

Regarding claims 14 and 15, in the system of Mason the deactivation prompt comprises an animated/audio prompt provided by an audio device.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 5, 6, 8-10, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mason (US 6,497,361).

Mason discloses a customer self-checkout system for processing article purchases of articles, as applied above in the rejection of claim 1 under 35 U.S.C. 102(e), but Mason fails to disclose that the database system coupled to the self-checkout station and comprising stored data identifying articles having attached security tags also stores data on articles not having attached security tags to determine whether the article designated by the received product code input has an attached security tag; and wherein the prompting system is configured to present the deactivation prompt when the article has an attached security tag and to not present the deactivation prompt when the article does not have an attached security tag, the system of Mason presenting the deactivation prompt when the stored data associated with the article does not indicate whether said article has an attached security tag or not, since the system of Mason seems to assume that all items in the store would have a security tag needing to be deactivated.

However, it is well known to those of ordinary skill in the art, that, ordinarily, due to the cost of the security tags, not all items in a store are provided with security tags, and it would be self-evident/inherent that items not having security tags would not need to have a security tag deactivated.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the system of Mason so as to use/store in the database of item weights, an indication as to whether or not each item is protected by a security tag, and to only deactivate tags for items that have such tags, as is well known to do, in order to accommodate stores having a mix of inventory partially protected by security tags and partially not protected by security tags, since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

Regarding claim 8, the system of Mason further comprises a bagging platform 44 and a scale 40 operatively coupled to the prompting system and configured to detect weight of bagged articles; and wherein the prompting system is configured to present the deactivation prompt when a weight change is detected by the bagging scale and the sensor has not sensed presence of the article within the deactivation region, but the scale of Mason is arranged to detect the weight of the bagged articles prior to the articles being placed into the bag, thus the bagging platform 44 does not comprise the scale 40. However, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the system of Mason so as to place either the scale, or else a second scale, under the bagging area 44, in order to confirm that the weight of the articles placed into bags would be the same as the weight of the articles that were scanned,

for security purposes, merely as a matter of design choice, since so doing could be done readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

Regarding claim 9, in the system of Mason the prompting system is configured to present a bagging prompt providing instructions to a user to place the article into a bag on the bagging platform 44.

Regarding claim 10, in the system of Mason the bagging platform further comprises a bag holder adapted to hold a bag for receiving articles.

### ***Response to Arguments***

9. Applicant's arguments filed June 29, 2007 have been fully considered but they are not deemed persuasive.

10. Regarding the argument that Mason does not disclose prompting the customer, Mason discloses various embodiments with various levels of automation, but at least one embodiment of Mason comprises a manual arrangement, with the customer moving the items to/from the various areas, "prompted as necessary by touch-screen display 24 and speaker 34" (see, for example, column 4, lines 16-20).

11. To the extent that applicant is arguing that the disclosure in the applied prior art is not in as complete detail as is recited by the instant claims, a reference anticipates a claim if it discloses



the claimed invention such that a skilled artisan could take its teachings *in combination with his own knowledge* of the particular art and be in possession of the invention. *In re Graves*, 36 USPQ2d 1697 (Fed. Cir. 1995); *In re Sasse*, 207 USPQ 107 (CCPA 1980); *In re Samour*, 197 USPQ 1 (CCPA 1978).

12. Regarding the argument that the references applied in the rejection fail to use the same names for certain elements as the names used by applicant, the argument is irrelevant, as it is noted that the disclosure in a reference must show the claimed elements arranged in the same manner as in the claims, but *need not be in the identical words* as used in the claims in order to be anticipatory. See *In re Bond*, 15 USPQ2d 1566 (Fed. Cir. 1990).

13. Regarding the arguments concerning applicant's intended use of the claimed apparatus, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

***Conclusion***


14. The prior art made of record and not relied upon is considered pertinent to the disclosure.
15. Any inquiry concerning this communication, or earlier communications, should be directed to the examiner, **Jerry O'Connor**, whose telephone number is **(571) 272-6787**, and whose facsimile number is **(571) 273-6787**.

Official replies to this Office action may now be submitted electronically by registered users of the EFS-Web system. Information on EFS-Web tools is available on the Internet at: <http://www.uspto.gov/ebc/portal/tools.htm>. An EFS-Web Quick-Start Guide is available at: <http://www.uspto.gov/ebc/portal/efs/quick-start.pdf>.

Alternatively, official replies to this Office action may still be submitted by any *one* of fax, mail, or hand delivery. **Faxed replies should be directed to the central fax at (571) 273-8300.** Mailed replies should be addressed to "Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450." Hand delivered replies should be delivered to the "Customer Service Window, Randolph Building, 401 Dulany Street, Alexandria, VA 22314."

GJOC

September 17, 2007



9/17/07

Gerald J. O'Connor  
Primary Examiner  
Group Art Unit 3627